

REMARKS

Claims 1-24 are pending. Claims 25-29 have been canceled without prejudice; applicants reserve the right to present these claims in a divisional application. Claims 1, 6, 11, 13-14, and 18-21 have been amended in the present paper. It should be noted that claims 17 and 21 have been amended solely to correct typographical errors.

At the outset, Applicants would like to thank the Examiner for the courtesies extended during the May 18, 2004 telephonic interview with Applicants' representative.

In the Office Action, Claims 1-6 and 9-12 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. 6,076,101 to Kamakura et al. ("Kamakura"). Claims 7-8 and 13-24 were rejected under 35 U.S.C. § 103(a) as obvious over Kamakura. Claim 18 was rejected under 35 U.S.C. § 101. Further, claims 3 and 17 were objected to.

Kamakura is directed to a system for providing e-mail recipients with an incentive to respond to e-mails. (Kamakura, Abstract.) Accordingly, Kamakura discloses sender and recipient terminals exchanging emails through an e-mail server. (Kamakura, Fig. 2.) Kamakura provides e-mail recipients with bonus points, redeemable for free gifts, in exchange for responding to e-mails. (Kamakura, Abstract.) Notably, Kamakura nowhere discloses that e-mail recipients physically visit the party responsible for sending the e-mails; indeed, Kamakura never gives the slightest hint as to who these parties are, or gives any suggestion that they could or should come into physical contact. The present invention, in contrast, is clearly directed toward "develop[ing] and strengthen[ing] the affinity between a merchant and its patrons." (*E.g.*, specification, paragraph 8.) That is, the present invention is not directed toward encouraging users simply to respond to e-mails, as is Kamakura, but rather is directed toward encouraging patrons to visit merchants on whose behalf e-mails have been sent.

Claim Objections

The Examiner objected to claim 3 (Office Action, page 3) on the ground that the claim "appears to be broad" in its recitation that "said clearinghouse facilitates the exchange of

patron information between different merchants.” The Examiner has chosen to interpret claim 3 as reciting that “said clearinghouse facilitates the delivery of e-mail messages from different merchants to the patrons and the patrons’ replies or responses to incoming e-mail messages.”

The Examiner’s interpretation of the claim is inappropriate at least because it changes the meaning of the claim. While not wholly clear to Applicants, the Examiner’s interpretation appears to direct the claim away from its recitation of an exchange of information between merchants and toward an exchange of information between merchants and patrons. There can be no justification for simply re-writing Applicants’ claim.

Further, claim breadth is not a proper ground for objecting to a claim, nor, for that matter, is breadth a proper ground for a rejection under 35 U.S.C. § 112. Applicants believe the claim language to be clear on its face. Moreover, the recited claim language is supported by the Specification, which explicitly discusses the exchange of patron information between different merchants, without limiting the manner in which this exchange occurs. (*See, e.g.*, Specification, paragraph 13.) Accordingly, Applicants respectfully request that the Examiner withdraw the objection to claim 3.

The Examiner objected to claim 17 for containing a typographical omission. Claim 17 has been amended to correct this typographical omission. Accordingly, Applicants respectfully request that the Examiner withdraw the objection to claim 3.

Section 101 Rejection

Claim 18 was rejected under 35 U.S.C. § 101. Applicants strongly disagree with the Examiner’s grounds for rejecting claim 18 under Section 101, inasmuch as the recited manual transfer of information clearly produces a useful, concrete, and tangible result. However, to expedite prosecution of this application, claim 18 has been amended so that it no longer recites using “a manual transfer of information.” Accordingly, the rejection of claim 18 under 35 U.S.C. § 101 should be withdrawn.

Section 102 Rejections

Independent claim 1, and claims 2-6 and 9-12, depending from claim 1, were rejected under 35 U.S.C. § 102(e) as anticipated by Kamakura. Applicants respectfully submit that claim 1 as amended is clearly patentable over Kamakura.

Kamakura teaches a system for providing users with incentives to respond to e-mails. (Kamakura, Abstract.) However, nowhere does Kamakura disclose the merchants, clearinghouse, or patrons recited in claim 1. Thus, Kamakura fails to disclose at least that a “clearinghouse provides electronic communications including information or promotional offers about at least one of said merchants to a subset of said participating patrons” as is recited in claim 1. Rather, Kamakura generically teaches sender terminals using an e-mail server to send e-mail messages to recipient terminals. (See Kamakura, Fig. 1.) In the May 18, 2004 interview with Applicant’s representative, the Examiner stated that Kamakura’s sender terminal corresponds to a merchant, its e-mail server to a clearinghouse, and its recipient to a patron. However, Kamakura’s Figures 1 and 2 teach away from such correspondences by making clear that Kamakura’s sender, e-mail server, and recipient are merely components in a computer system. Thus Kamakura clearly does not teach the recited merchants, clearinghouse, or patrons.

Kamakura also clearly fails to disclose providing electronic communications that include “information or promotional offers about at least one of said merchants.” Kamakura is wholly silent as to the contents of the e-mail messages sent by its system. In fact, Kamakura teaches away from e-mail messages including “information or promotional offers about at least one of said merchants” inasmuch as Kamakura teaches that the “free gifts or services offered by the original message sender” are provided via a redemption message sent *separately* from the original e-mail message. (Kamakura, col. 3, lines 49-56.) Thus, not only does Kamakura not disclose “information or promotional offers about at least one of said merchants”, but Kamakura would have suggested to one of ordinary skill in the art that such information or promotional offers should not be included in an e-mail message from its sender to its recipient.

Further, nowhere does Kamakura teach or suggest “a website including at least one electronic form”, or submitting an e-mail address “via the electronic form.” While Kamakura teaches storing recipients’ e-mail addresses, Kamakura is wholly silent as to how such recipients

are entered into its system. (*See, e.g.,* Kamakura, col. 3, lines 20-23.) Kamakura certainly does not teach a website, much less a website including an electronic form, for any purpose, much less as a means for its recipients to provide their e-mail addresses.

For at least the foregoing reasons, claim 1 is in condition for allowance, as are claims 2-18, depending directly or indirectly from claim 1.

Section 103 Rejections

Claims 7-8 and 13-24 were rejected under 35 U.S.C. § 103(a) as obvious over Kamakura. Claims 7-8 and 13-18 are patentable for at least the reasons stated above regarding independent claim 1. Also, independent claim 19, from which claims 20-24 depend, is patentable for at least the reasons stated above regarding claim 1.

Further, regarding claims 8, 14, 19, and 21, the Examiner concedes (Office Action, page 13) that “Kamakura does not explicitly disclose sending to a patron or recipient an e-mail or electronic communication containing a hyperlink” However, the Examiner discusses systems that are evidently within his personal knowledge and takes Official Notice (Office Action, page 14) that sending e-mails as recited in Applicants’ claims is taught in the prior art. Applicants note that at least one system referred to by the Examiner appears to be not a prior art system, but a system existing at the time the Office Action was prepared. As noted above, the only prior art cited by the examiner, Kamakura, teaches against the limitation of “e-mail communications [that] can be redeemed by said patrons or said patrons”. Certainly none of the prior art teaches e-mail communications that can be redeemed by patrons, much less e-mail communications containing a hyperlink, as is recited in the context of Applicants’ claims.

Similarly, the Examiner, without explicitly so stating, appears to take Official Notice with respect to “said e-mail address being verified through the sending of a test electronic communication to said participating patron” as recited in claim 7. (*See* Office Action, page 16.) Not only does the Examiner fail to provide a prior art reference reading on this limitation, much less a prior art reference providing a motivation for the limitation, but Applicants disagree that the receipt of an “undeliverable mail notification message” described by the Examiner reads on claim 7.

The Examiner also takes Official Notice (Office Action, page 17) with respect to the “unique identifier code” recited in claim 13. Applicants disagree that simply because different stores have different locations, the recitation of claim 13, taken in the context of Applicants’ claimed invention, would have been obvious to one of ordinary skill in the art. Certainly the “unique identifier code” recited in claim 13 is not found in the prior art of record.

The Examiner also takes Official Notice (Office Action, page 18) with respect to the recitation in claim 17 of “one of said buttons reflecting a redemption offer”. This limitation is plainly not found in the prior art of record, and Applicants disagree that “a reward or redemption button”, particularly in the context of Applicants’ claimed invention, is “old and well established in the art.”

Accordingly, Applicants strongly disagree with each instance of Official Notice taken by the Examiner. Applicants hereby seasonably challenge each instance of Official Notice taken by the Examiner in accordance with 37 CFR 1.104(d)(2) and MPEP §2144.03. Therefore, in response to this communication the Examiner is required to produce documentary proof with respect to each taking of Official Notice as evidence of the Official Notice taken. In the event that the Examiner does not produce documentary proof, it is respectfully requested that each rejection based on Official Notice be withdrawn.

At least for the foregoing reasons, each of claims 7-8 and 13-24 are in condition for allowance.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe that a fee of \$950 is due with this response. Please charge this fee to our Deposit Account No. 18-0013, under Order No. 65744-0002 from which the undersigned is authorized to draw.

Dated: May 25, 2004

Respectfully submitted,

By 

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